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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,687	09/08/2003	Salvatore Rea	2002L007A	1241

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EXAMINER

RONESI, VICKEY M

ART UNIT PAPER NUMBER

1714

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,687

Applicant(s)

REA ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The outstanding claim objections are withdrawn in light of applicant's amendment filed 6/26/2006.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 103

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogano et al (US 6,207,625, cited on IDS dated 12/24/2003) in view of Brehm (US 3,893,168) and Holubec (US 3,876,550).

The rejection is adequately set forth in paragraph 2 of office action mailed 3/23/2006 and is incorporated here by reference.

5. Claims 1-9 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 6,444,624) in view of Brehm (US 3,898,168) and Holubec (US 3,876,550).

The rejection is adequately set forth in paragraph 3 of office action mailed 3/23/2006 and is incorporated here by reference.

Double Patenting

6. Claims 1-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,642,188 alone or in view of Holubec (US 3,876,550).

The rejection is adequately set forth in paragraph 4 of office action mailed 3/23/2006 and is incorporated here by reference.

7. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,642,188.

The rejection is adequately set forth in paragraph 6 of office action mailed 3/23/2006 and is incorporated here by reference.

Response to Arguments

8. Applicant's arguments filed 6/26/2006 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that neither Walker et al nor Ogano et al deals with the same problem as applicant; (B) that Walker et al and Ogano et al do not provide any suggestion of the advantage had by the present use of at least 1200 P and 15-1000 ppm Mo as established by the data in the parent application; and (C) that Brehm does not teach mixtures of antirust agents, and therefore it would have not have been obvious to one of ordinary skill to use mixtures even when taught by Holubec.

With respect to argument (A), although Walker et al and Ogano et al use its composition in a different capacity than applicant, case law holds that it "does not alter the conclusion that its

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use in a prior art composition would have been *prima facie* obvious from the purpose disclosed in the reference.” *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). While applicant asserts that there is no teaching or suggestion in Walker et al to obtain the presently claimed combination of ingredients, examiner disagrees given the table in column 7 and examples which clearly suggest the presently claimed combination. In Ogano et al, there is clear guidance that the composition contain 400-2000 ppm Mo (col. 4, lines 7-52) and 700-2000 ppm P (col. 4, line 53 to col. 4, line 22), both of which overlap with the presently claimed ranges, wherein the addition of other ingredients is typical for the art.

With respect to argument (B), the examiner has analyzed the data of the parent application and has found it to be insufficient to establish criticality for the claimed combination because the examples are not proper side-by-side examples and the data is not commensurate in scope with the claimed invention. In particular, the ingredients of the comparative example are not given and it is not possible to determine which ingredient contributes to the observed difference. Furthermore, only one inventive example is provided which is not reasonably commensurate in scope with the claimed invention. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983).

With respect to argument (C), first, note that the amounts of rust inhibitors are taught by the primary references, both Walker et al and Ogano et al, wherein each of the primary references teaches alkenyl succinic acid ester as rust inhibitors (i.e., presently claimed rust inhibitor (ii)) and it would have been well within the capabilities of one of ordinary skill in the art to utilize suitable amounts of rust inhibitor. Second, Holubec is used to merely bolster the

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position that it is obvious to combine two ingredients, each of which is used for the same purpose. Further evidence is found in case law which states that it is *prima facie* obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Lindner* 457 F. 2d 506, 509, 173 USPQ 356, 359 (CCPA 1972). Third, should applicant rely on the inventive and comparative data of the instant specification to establish surprising and unexpected results for the combination of the two rust inhibitors, it is noted that such data is not commensurate in scope with the claimed invention.

Conclusion

9. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/28/2006
Vickey Ronesi



VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700